

REMARKS/ARGUMENTS

In the Restriction Requirement dated June 5, 2008, the Examiner delineated the following inventions as being patentably distinct:

Group I: Claims 1-16 and 18-19, drawn to a pyrogenically produced silicon dioxide and the process of making the pyrogenically produced silicon dioxide;

Group II: Claim 17, drawn to a method of adjusting the rheology of paint or coating; and

Group III: Claim 20, drawn to a method of making paper.

Accordingly, Applicants provisionally elect with traverse Group I, Claims 1-16, 18 and 19 drawn to a pyrogenically produced silicon dioxide and the process of making the pyrogenically produced silicon dioxide.

The claims of Groups I-III are integrally linked as process for making and method of use.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinction (M.P.E.P. § 803).

There is a technical relationship that links Groups I, II and III, and it is this technical relationship that defines the contribution which each of the groups taken as a whole makes over the prior art.

In the instantly claimed invention, the silicon dioxide produced by Group I claims is used in adjusting the flow (rheology) of the paint and subsequently the method of making paper.

The Examiner asserts that Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 and 13.2 because they lack the same corresponding technical feature. The Examiner has not considered that the claims in each group are considered to have related inventions under 37 C.F.R. § 1.475(b) in which the inventions are considered to have unity of invention. Applicants submit that while Rule 13.1 and 13.2 are applicable 37 C.F.R. § 1.475(b) provides in relevant part that a “national stage application containing claims to different categories of invention are considered to have unity of invention if the claims are drawn to ... (e) a product, process especially adapted for the manufacture of said product and a method of using said product ...”.

Moreover, Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. As the Office has not shown any evidence that a restriction should now be required when the International Preliminary Report did not, restriction is now believed to be improper. Unity of invention has to be considered in the first place only in relation to the independent claim. A dependent claim is one which contains all the features of another claim and is in the same category of claims as other claims. It does not matter if a dependent claim itself contains a further invention.

Further, M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

For the reasons recited above, Applicants request that the Restriction Requirement be withdrawn.

Divisional applications filed thereafter claiming the non-elected subject matter should not be subject to double-patenting grounds of rejection, 35 U.S.C. § 121, *In re Joyce*, (Comm. Pat. 1957), 115 USPQ 412.

Applicants submit that the above identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

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A handwritten signature in black ink, appearing to read "Paul J. Killos", is written over a horizontal line.

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